

REMARKS

Claims 1-6 are pending in the above-identified application. Support for new claims 5 and 6 is found in original claims 3 and 4.

Double Patenting Issues

Claim 1 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of co-pending Application No. 10/254,598 (US 2003/0099900 A1, the '598 Application) in view of Urano '759 (USP 5,976,759).

Claim 1 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of co-pending Application No. 10/233,519 (US 2003/0114589 A1, the '519 Application) in view of Urano '759.

Claim 1 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of co-pending Application No. 10/084,182 (US 2002/0164540 A1, the '182 Application) in view of Urano '759.

Request that "Provisional" Double Patenting Rejections Be Withdrawn

It is requested that all of the above-noted "provisional" double patenting rejections be withdrawn so that the present application be allowed to grant as a patent. First, please note

that the present application has the earliest effective U.S. filing date. Second, please note that MPEP 822.01 states that if the provisional double patenting rejection is the only outstanding rejection remaining in an application, this type of rejection should be removed to allow the application to grant as a patent which will then allow the Examiner the option of converting the double patenting rejection in the other co-pending applications into double patenting rejections which are not "provisional". It is submitted for the reasons stated below that all other rejections have been overcome and should be removed. Consequently, it is additionally required that all of these provisional double patenting objections be withdrawn.

Issues Under 35 U.S.C. 103(a)

Claims 1-4 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barclay '086 (USP 6,492,086) in view of Nakamura '656 (USP 6,514,656).

The above-noted rejection is traversed for the following reasons.

Distinctions Between the Present Invention and Barclay '086

Barclay '086 discloses components for chemically amplified positive-acting resists which include polymers that contain repeating units of phenol and photoacid-labile esters that contain an alicyclic group which is preferably a bulky group that may contain 7-20 carbon atoms, such as an alkyladamantyl group as noted at the bottom of column 2. Barclay '086 further discloses at column 12, lines 36-45 that the described photoresists may contain "other optional materials", such as "plasticizers" in "minor concentrations."

Barclay '086 fails to disclose or reasonably suggest the use of polypropylene glycol together with other polymeric components, such as an alkyladamantyl group as in the composition of the present invention. Consequently, Barclay '086 fails to recognize the advantageously improved scum or residue reducing effects caused by the presence of the polypropylene glycol (PPG) in the composition of the present invention as evidenced by the comparative tests results shown in Table 2 at page 19 of the specification. In this regard, note that Table 2 shows that Examples 1-3 (present invention) all exhibit advantageous scum or residue prevention as compared to Comparative Example 1 which did

not include any PPG. Thus, significant patentable distinctions exist between the present invention and Barclay '086.

Distinctions Between the Present Invention and Nakamura '656

Nakamura '656 discloses positive type image forming materials which include an alkali aqueous solution soluble polymer compound (A), a light and heat decomposing compound (B), and a cross-linkable compound (C) as noted at the bottom of column 2. Nakamura '656 further discloses at column 35, lines 31-41 that the described compositions may additionally include:

... plasticizers (for example, tricresyl phosphate, dimethylphthalate, diburylphthalate, trioctyl phosphate, tributyl phosphate, tributyl citrate, polyethylene glycol, polypropylene glycol and the like) for imparting flexibility and abrasion resistance to a film.

Nakamura '656 fails to disclose a chemical amplifying type positive resist composition which includes a resin having a polymerization unit derived from an alkyladamantyl group as in the composition of the present invention. Consequently, significant patentable distinctions exist between the present invention and Nakamura '656.

In addition to the above, it is submitted that Nakamura '656 cannot be combined with Barclay '086, since Nakamura '656 employs different components in the described compositions which fail to

include the required component of Barclay '086, i.e. photoacid-labile esters that contain an alicyclic group which is preferably a bulky group of 7-20 carbon atoms, such as an alkyladamantyl group. The fact that Nakamura '656 and Barclay '086 both happen to mention as a possible optional ingredient "plasticizers" fails to overcome the significant inconsistency in the required polymeric components for each of the described compositions. In this regard, it is submitted that many possible plasticizer components could optionally be added to the compositions described in Barclay '086, not limited to the list of plasticizers mentioned in Nakamura '656 especially in view of the significant inconsistencies in the required active ingredients for both the compositions described in each of these documents. Therefore, it is submitted that Barclay '086 simply cannot be combined with Nakamura '656.

Submission of Additional Evidence Supporting Patentability

It is further submitted that enclosed with this Reply is a Declaration (hereinafter the "Nakanishi Declaration") which is submitted under 37 C.F.R. 1.132. The Nakanishi Declaration shows that most of the disclosed plasticizers at column 35 of Nakamura '656 (note page 3 of the Nakanishi Declaration) exhibit disadvantageously poor prevention of scum or residue as evidenced

by the summarized comparative experimental test results in Table 1 at page 6 of the Nakanishi Declaration. Consequently, even if a person skilled in the art ignored the significant differences in the compositions described by Nakamura '656 and Barclay '086 (as noted above), the list of exemplified plasticizers provided in Nakamura '656 would merely provide a list of examples for experimentation, with most of the examples failing to achieve the advantages achieved by the present invention. Consequently, this further evidence establishes that the disclosures of Nakamura '656 and Barclay '086 merely provide some broad suggestions for experimentation which falls short of prima facie obviousness. In this regard, it is noted that if the claimed invention is merely within the capabilities of one of ordinary skill in the art, this fails to be sufficient by itself to establish prima facie obviousness. *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

### Conclusion

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should now be placed condition for allowance.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No.

Appl. No. 10/046,742

32,868), in the Washington Metropolitan Area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to Sunday, July 11, 2004, in which to file a reply to the Office Action. The required fee of \$420.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Andrew D. Meikle, #32,868

ADM:gmh  
2185-0612P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment(s): Declaration of Junji Nakanishi